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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/947,668	10/09/1997	TRACEY C. SLEMKER	534128-002-C	6180
8698	7590	08/12/2004	EXAMINER	
STANDLEY LAW GROUP LLP 495 METRO PLACE SOUTH SUITE 210 DUBLIN, OH 43017			WILLSE, DAVID H	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/947,668

Applicant(s)

SLEMKER, TRACEY C.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43-48, 50-55 and 64-86 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 64-78 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 81, 82 and 85 is/are allowed.
- 6) ☒ Claim(s) 44-48, 50, 51, 55, 79, 80, 83, 84, and 86 is/are rejected.
- 7) ☒ Claim(s) 52-54 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Claims 44-48, 55, 83, and 86 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. In claim 83, the last three lines are inaccurate because there is a substantial air pocket **34** between the distal end of the residual limb and the base-plate **16** (Figure 1; column 4, lines 18-24). Regarding claims 44-48 and 50-55, the base including the interface cushion **28** contradicts the specification of parent US 5,702,489 at column 3, lines 17-19, and column 4, lines 6-8 and 15-16, and contradicts present application original claims 3-5, 9, and 11, all of which indicate that the base and the cushion member are separate entities. Therefore, the last three lines of claim 44 are inaccurate for the same reasons as in claim 83, and claims 48 and 55 are deemed to be misleading or confusing relative to the original disclosure. Because of the procedure outlined in M.P.E.P. 2163.06 for interpreting the claims, it is noted that prior art may be applicable under 35 U.S.C. 102 or 35 U.S.C. 103(a) once the aforementioned problem under 35 U.S.C. 112, first paragraph, is corrected.

Claims 79, 80, and 84 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 79, lines 3 and 4, it is unclear whether “a distal end” and “an exterior distal end” are supposed to be the same element or different elements.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 50 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fishman et al., US 5,007,937, which discloses a substantially impermeable sleeve in the form of a sealing band **12**, which can be “filled with a pressurized gas, such as air, or a liquid” (column 8, lines 44-47). The inner surface of the socket **P** provides sealing contact with a substantial portion of an outer surface of said sleeve **12** (column 4, lines 33-36; etc.). The valve **V** being removably coupled to a distal end or portion of the socket **P** would have been obvious in order to facilitate cleaning, replacement, etc. Fluid transfer is enabled prior to full insertion of the residual limb, as seen from column 4, lines 33-44. Substantially no air pockets between a distal end of the residual limb and a bottom of the receiving cavity would have been immediately obvious, if not inherent, from the Fishman et al. invention being applicable to “a great many well-fitted prosthetic sockets” (column 2, lines 3-7) and from the behavior described at column 4, lines 42-50; column 1, lines 29-32 and 42-48; etc. Regarding claim 51, pumps for donning and doffing were well known in the art at the time of the present invention and would have been an obvious accessory for physically challenged amputees.

Claims 79, 80, and 84 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Claims 52-54 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Claims 81, 82, and 85 are allowed.

The Applicant's remarks have been reviewed and are adequately addressed in the grounds of rejection presented above. The added rejection based upon Fishman et al. was necessitated by the revisions to claim 50 at line 2 and at lines 17-19. Therefore:

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is (703) 308-2903. The examiner can normally be reached Monday through Thursday and often on Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.


Dave Willse
Primary Examiner
Art Unit 3738